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In re Application of EGELAND et al	:	
U.S. Application No.: 10/574,818	:	
PCT Application No.: PCT/GB2004/004390	:	
Int. Filing Date: 15 October 2004	:	DECISION
Priority Date Claimed: 15 October 2003	:	
Attorney Docket No.: 2006_0521A	:	
For: ELECTROCHEMICAL TREATMENT OF	:	
SUBSTRATES	:	

This is in response to applicant's "Petition Under 37 CFR 1.45(c) and 35 USC 118" filed 20 June 2007, which is being treated under 37 CFR 1.47(b).

**BACKGROUND**

On 15 October 2004, applicant filed international application PCT/GB2004/004390, which claimed priority of an earlier United Kingdom application filed 15 October 2003. A copy of the international application was communicated to the USPTO from the International Bureau on 28 April 2005. The thirty-month period for paying the basic national fee in the United States expired on 15 April 2006.

On 06 April 2006, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 21 December 2006, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 20 June 2007, applicant filed the present petition under 37 CFR 1.47(b).

### DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

With regard to item (1) above, applicant is advised that effective 22 November 2004, the fee for a petition under 37 CFR 1.47 increased to \$200.00. Any deficiency in the petition fee will be charged to Deposit Account No. 23-0975 as authorized by applicant.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

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Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that the sole inventor Ryan Egeland either cannot be located or refuses to sign the application papers. Although the petition demonstrates that a diligent effort was made to find Dr. Egeland, it is apparent that Dr. Egeland resides at the Chicago, Illinois address and works at Northwestern Memorial Hospital in Chicago, Illinois (see affidavit of Michael Bennett). Thus, it cannot be reasonably alleged that Dr. Egeland cannot be located.

Dr. Egeland's conduct, however, evidences a probable refusal to cooperate. In particular, Dr. Egeland has failed to respond to repeated telephone and electronic mail messages, has apparently refused to accept delivery of correspondence mailed to him, and has apparently avoided personal contact with an investigator (see Bennett affidavit). However, before it can be concluded that Dr. Egeland refuses to join in the application, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (including specification, claims, drawings, and oath/declaration) to Dr. Egeland for signature. Presently, petitioner has illustrated that only declaration and assignment papers were sent to Dr. Egeland.

With regard to item (3) above, the petition states the last known address of the nonsigning inventor.

With regard to item (4) above, an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor has been provided.

With regard to item (5) above, the 37 CFR 1.47(b) applicant must prove that, as of the date the application was deposited in the Patent and Trademark Office, (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application. MPEP 409.03(f).

In the present case, the petition states that Dr. Egeland agreed in writing to assign the invention to Oxford Gene Technology IP Limited ("OGT"). Petitioner has provided a copy of an agreement signed by Dr. Egeland which grants OGT the exclusive ownership of intellectual property which is the result of work performed by Dr. Egeland during his employment with OGT (see Exhibit 1). However, petitioner has not established that the present invention was made during and contributed to OGT while Dr. Egeland was employed by OGT. In particular, an affidavit signed by the person who personally observed Dr. Egeland creating the subject matter of the present invention has not been furnished. Thus, it would not be reasonable to conclude at the present time that OGT has sufficient proprietary interest.

With regard to item (6) above, the petition includes an adequate statement with regard to the preservation of rights of the parties and/or the prevention of irreparable damage.

### CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(b) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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